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In re Application of :
Ulf Landegren :
Serial No.: 08/981,310 : PETITION DECISION
Filed: December 16, 1997 :
Attorney Docket No.: 1209-0121P :

This is a decision on the petition under 37 CFR 1.181, filed November 5, 2002, to require the examiner to enter an amendment. The delay in acting on this petition is regretted.

BACKGROUND

A review of the file history shows that this application was filed with 8 claims with claim 3 reciting that "the affinity reagents are lectins, receptors, single claim antibodies, cofactors and nucleic acids". This specific language did not appear *in haec verba* in the specification although the description of Figure 1 in the specification contains a similar, but not identical, list of such reagents. Following the filing of a CPA request the examiner in an Office action mailed May 21, 2001, for the first time rejected claims 1, 3 and 4 under 35 U.S.C. 112, first paragraph, as lacking support in the specification, as originally filed, for the phrase noted above.

In response applicant argued that the reagents of claim 3 were described in Figure 1 in general terms. In response the examiner mailed a Final Office action to applicant on January 16, 2002, maintaining the rejection of claims 1, 3 and 4 under 35 U.S.C. 112, first paragraph, arguing that the referenced portion of the specification does not provide sufficient support for the limitations of claim 3.

Applicant replied to the Final Office on May 16, 2002, action by proposing an amendment to the specification which inserted a paragraph essentially identical to original claim 3, changing the "and" to "or" for clarity. The same change had previously been made to claim 3 after the first Office action. The examiner, by means of an Advisory Action mailed June 19, 2002, refused entry of the amendment on various grounds and specifically commented that the paragraph insertion would raise the aspect of "new matter" in the specification. On July 16, 2002, a Notice of Appeal was filed. This petition was filed on November 5, 2002, concurrently with the Appeal Brief.

DISCUSSION

Initially it is noted that this petition was filed almost four months after the repeated action of the

examiner which is well beyond the two month non-extendable time period set in 37 CFR 1.181(f) which may be used as grounds for dismissal of this petition. However, where the interests of applicant and the Office are significant, such requirement may be withdrawn and the petition decided on the merits.

Applicant petitions the decision of the examiner not to enter the amendment to the specification inserting the limitations of claim 3 into the specification on page 3, changing only the word "and" to "or" for clarity. Entry of the amendments to the claims was not petitioned. The examiner argues that the amendment lacks support in the original disclosure even when considering the original claims as part of the original disclosure. The examiner specifically states that "the macromolecule of (original) claim 1 was not defined to be a protein".

The examiner's statement is correct. However, looking to the specification for definition of "macromolecule", one finds at page 3, lines 14-15, that the test kit comprises a first reagent having affinity for a specific macromolecule, such as a protein. Thus original claim 1, although it does not define macromolecule itself, must be considered to encompass the description of macromolecule as set forth in the specification which includes protein. Further, the examiner has not objected to the amendment to original claim 1 which adds the limitation that the "macromolecule is a protein", thus accepting it as part of the original description of the specification. There is therefore no reasonable argument that the limitation of claim 3 does not refer to proteins and cannot be inserted into the specification since it is supported by the original disclosure.

DECISION

Applicants' petition is **GRANTED**.

The amendment to the specification inserting the proposed paragraph at page 3 will be permitted entry if presented as a separate paper. The other amendments proposed in the amendment after Final rejection were not addressed in the petition and have not been considered. Thus the requirement for presentation of the proposed amendment to the specification in a separate paper.

There is no fee for this petition and the petition fee paid of \$130.00 will be credited to applicant's Deposit Account No., 02-2448, as directed.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.



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